



PATENT
Customer No. 22,852
Attorney Docket No. 09354.0003-00 (Previously 07336.0003-00)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Mariko OKAMOTO et al.)	Group Art Unit: 1615
)	
Application No.: 09/667,420)	Examiner: B. FUBARA
)	
Filed: September 21, 2000)	
)	Confirmation No. 8873
For: GEL COMPOSITION AND ITS USE IN)	
COSMETIC COMPOSITIONS AND)	
THE LIKE)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated December 6, 2005. Appellants do not believe that a fee is due in connection with the filing of this paper. However, if any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. Status of Rejections

In response to the Appeal Brief filed September 23, 2005, the Examiner has maintained the rejection of claims 1-4, 6-10, and 18-41 under 35 U.S.C. § 103(a) as unpatentable over Japanese Application No. JP 11-021227 (*“the JP reference”*) and U.S. Patent No. 5,976,510 to Cernasov et al. (*“Cernasov”*). Answer, page 3.

II. Response to Examiner’s Arguments in the Answer

Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-4, 6-10, and 18-41 based on *the JP reference* and *Cernasov* for the reasons set forth in the Appeal Brief filed September 23, 2005, as well as those below.

**A. Claims 1-4, 6-10, and 18-40 Are Patentable
over *the JP Reference* and *Cernasov***

1. Lack of A Suggestion or Motivation to Modify or Combine

First, the Examiner has failed to point to any evidence of any suggestion or motivation to modify or combine *the JP reference* and *Cernasov*.

In the Answer, the Examiner repeatedly cited *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) in support of her allegations that “because the JP composition and the Cernasov composition are useful for cosmetic applications and the cosmetic products are individually disclosed by the prior art,” it would have been obvious to combine them “to form a third composition to be used for the very same

purpose,” and that “[t]he motivation is that the third composition would be expected to be [a] cosmetic composition that would retain moisture and a composition that would not stick.” Answer, pages 6-7; *see also* Answer, pages 4 and 10. Appellants respectfully disagree with the Examiner.

As an initial matter, it is impermissible for the Examiner to rely on the *Kerkhoven* case as a short-cut attempt to establish a *prima facie* case of obviousness without first establishing the elements of a *prima facie* case as required by the Supreme Court’s decision in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

Moreover, as set forth in the Appeal Brief, pages 15-16, neither the facts nor the holding of *Kerkhoven* applies to the present case. Even, solely for the purpose of argument, if the Examiner were correct, for at least the following reason, it would be an absurd conclusion that any cosmetic compositions individually taught in the prior art would have been obvious to be combined because of the expectation that the resulting composition would possess the combined properties of the original cosmetic compositions.

One of ordinary skill in the art would not expect that the resulting composition would possess the combined properties as alleged by the Examiner, because the combination of cosmetic compositions is not merely physical mixing and does not follow the simple math of one plus one being equal to two due to the fact that potential interaction and/or reaction of the chemical components in the cosmetic compositions and other factors, such as stability of the resulting composition, do exist and have an influence on the formation of the resulting composition.

The Examiner further alleges that “the suggestion is a pigment that results ‘in a significantly higher moisture content for the skin’” (citing *Cernasov*, col. 2, lines 65-67) and that “[t]he motivation is to produce a cosmetic [composition] that would retain moisture [with an expectation] that the composition would retain moisture on the skin.”

Answer, page 7.

As set forth in the Appeal brief, page 13, *Cernasov* clearly teaches that it is not the perfluoroalkyl phosphate treated pigment itself, but the combination of the perfluoroalkyl phosphate treated pigment with the dispersants and the selected oily phase, that leads to high moisture content for the skin.

Moreover, *the JP reference* teaches that its composition by itself has moisturizing capability without stickiness. *The JP reference*, English translation, page 1. Therefore, based on this fact alone, and contrary to the Examiner’s allegation, one of ordinary skill in the art would not be motivated to modify *the JP reference* or combine it with *Cernasov* in order to obtain a composition for moisturizing the skin.

2. Lack of A Reasonable Expectation of Success

The Examiner further alleges that, in the Appeal Brief, the cited disclosures of *Cernasov*, column 1, lines 10-14, and column 2, line 58- column 2, line 3, do not support Appellants’ position that “*Cernasov* recognizes that one cannot simply pick and choose one ingredient in one composition and combine it or the composition itself with another composition without potentially changing the nature and stability of the final products.” Appellants respectfully disagree.

The Examiner admits that *Cernasov* in column 1, lines 10-14 “was presenting the state of the prior art and problem that needed to be solved.” Answer, page 8. In column 1, lines 10-14, *Cernasov* clearly teaches that a “well-balanced composition is essential to achieving a stable emulsion . . . because individual components with frequently conflicting characteristics must be integrated into such an emulsion.” In other words, it is common knowledge to one of ordinary skill in the art that forming a stable emulsion requires a delicate balance to accommodate the individual components with conflicting characteristics.

In column 1, line 58- column 2, line 3, *Cernasov* further teaches that the pigments treated with a perfluoroalkyl phosphate “acquire water and oil-repellent characteristics” and “the subsequent processing in certain cosmetic products is not generally possible due to the water and oil-repellent characteristics.” In other words, *Cernasov* teaches that because the pigments treated with a perfluoroalkyl phosphate acquire water and oil-repellent characteristics, it is generally not possible to form a stable emulsion comprising those pigments.

In view of these disclosures, one of ordinary skill in the art would understand that forming a stable emulsion using the pigments treated with a perfluoroalkyl phosphate is difficult, requiring a delicate balance to accommodate the pigments’ water and oil-repellent characteristics. Therefore, without using the present invention as a blueprint, one of ordinary skill in the art would not have a reasonable expectation of success of forming a stable composition by simply picking and choosing the pigments treated with a perfluoroalkyl phosphate in *Cernasov*’s composition and combine it or the *Cernasov*’s

composition with the composition disclosed in *the JP reference*, as the resulting composition would likely not be stable in view of *Cernasov's* teachings. Accordingly, the Examiner's allegation that the cited disclosures in *Cernasov* do not support Appellants' position is baseless.

3. Rule 132 Declaration Supports Appellants' Positions

The Examiner also alleges that the Declaration under 37 C.F.R. § 1.132 filed March 5, 2004 ("the Rule 132 Declaration") "is not commensurate in scope with the claims because the claims are generic to pigment surface treated with broad fluorine compound while the comparison provided in the declaration is directed to single specified fluorine compound." Answer, page 9. Appellants respectfully disagree.

First, because the Examiner has not satisfied her burden to establish a *prima facie* case of obviousness as demonstrated above, the results shown in the Rule 132 Declaration are not relied upon by Applicants for rebutting a *prima facie* case of obviousness.

Second, in the Appeal Brief, Appellants relied on the Rule 132 Declaration in support of the position that "the combination of one cosmetic composition with another cosmetic composition is not merely physical mixing, because of potential interaction and/or reaction of the chemical components in the cosmetic compositions, which can disrupt the stability and formation of gelling compositions." Appeal Brief, page 13. Appellants further relied on the Rule 132 Declaration in support of the position that "one cannot simply pick and choose one ingredient in one composition and combine it or the composition itself with another composition without potentially changing the nature and

stability of the final products.” *Id.* at pages 16-17. The Examiner has failed to point to any evidence or to allege that the results shown in the Rule 132 Declaration do not support Appellants’ positions.

In addition, the M.P.E.P. clearly instructs that “[t]he nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof.” M.P.E.P. § 716.02(d) I. The Examiner has failed to point to any evidence or to allege that the fluorine compound treated pigments used in the tests as shown in the Rule 132 Declaration differ from other fluorine compound treated pigments. Therefore, the Examiner’s allegation is merely based on her subjective determination without any objective evidence in support thereof.

Further, the Examiner alleges that *Cernasov* “discloses that pigments treated with perfluoroalkyl phosphates ‘surprisingly results in a significantly higher moisture content for the skin than was thought to be possible’ (column 2, lines 65-67), thus the results are expected.” Answer, page 9.

The Examiner’s allegation is not only illogical, but also baseless, because the unexpected results shown in the Rule 132 Declaration are not directed to the moisture content for the skin, but to the formation of stable gel compositions.

Moreover, *Cernasov* in column 2, line 63 - column 3, line 1, clearly teaches that it is not the pigments treated with perfluoroalkyl phosphates alone, but the combination of the pigments treated with perfluoroalkyl phosphates with the dispersants and the

selected oily phase that provides the high moisture retention (“The special inventive combination of pigments treated with perfluoroalkyl phosphates of (a) and the dispersants of (b) in combination with the selected oily phase surprisingly results in a significantly higher moisture content for the skin than was thought to be possible.”) (Emphasis added).

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-4, 6-10, and 18-40, this rejection is improper and should be reversed and withdrawn.

B. Claim 41 Is Patentable Over *the JP Reference* and *Cernasov*

Finally, the Examiner alleges that “[o]ne of the objects of *Cernasov* is to provide [a] stable composition containing inorganic pigments that offer excellent moisture retention characteristics (column 1, lines 31-37),” and to achieve this object, *Cernasov* teaches the use of perfluoroalkyl phosphate treated pigments. Answer, page 10. Further, the Examiner alleges that because the “JP reference discloses [a] cosmetic composition that comprises [the] gelling agent that is based on polyacrylamide,” “the combined references disclose all the limitation of claim 41.” *Id.* Appellants respectfully disagree.

As discussed above, *Cernasov* teaches that the combination of the pigments treated with perfluoroalkyl phosphates with the dispersants and the selected oily phase provides high moisture retention. However, *Cernasov* does not teach or suggest “a process for stabilizing a gel composition” as recited in the present claim 41. Nor does *the JP reference*. Indeed, the Examiner merely relies on *the JP reference* for its

teaching of the gelling agent, which does not remedy this deficiency. Therefore, this rejection is improper.

Further, as discussed in subsection A, the Examiner has failed to point to any evidence of a suggestion or motivation to modify or combine the references nor any evidence of a reasonable expectation of success from such modification or combination.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness for claim 41, this rejection is improper and should also be reversed and withdrawn.

Conclusion

In view of the foregoing, Appellants respectfully submit that a *prima facie* case of obviousness has not been established, and request that the outstanding §103(a) rejection be reversed and withdrawn.

Respectfully submitted,

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